



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/315,116 05/19/99 ANTELMAN

D 16930-0010-2

020350 HM22/1004  
TOWNSEND AND TOWNSEND AND CREW  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO CA 94111-3834

EXAMINER

DAVIS, M

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

10/04/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

D 9/315/116

Applicant(s)

Examiner

Group Art Unit

1642

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 05-01-99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 16 - 37 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 16 - 37 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1642

## DETAILED ACTION

### *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 16, 18-33, 37, drawn to a method for treating a hyperproliferative disorder, by administering a fusion polypeptide, wherein RB domain is wild type RB56, or SEQ ID NO:4, and E2F polypeptide comprises about amino acid 95 to about amino acid 286 of SEQ ID NO:1, classified in class 514, subclass 2.
- II. Claims 16, 18-33, 37, drawn to a method for treating a hyperproliferative disorder, by administering a fusion polypeptide, wherein RB domain is wild type RB56, or SEQ ID NO:4, and E2F polypeptide comprises about amino acid 95 to about amino acid 194 of SEQ ID NO:1, classified in class 514, subclass 2.
- III. Claims 16, 18-33, 37, drawn to a method for treating a hyperproliferative disorder, by administering a fusion polypeptide, wherein RB has at least one substitution at amino acid 2, 608, 612, 788, 807, or 811, and E2F polypeptide comprises about amino acid 95 to about amino acid 286 of SEQ ID NO:1, classified in class 514, subclass 2.
- IV. Claims 16, 18-33, 37, drawn to a method for treating a hyperproliferative disorder, by administering a fusion polypeptide, wherein RB has at least one substitution at amino acid 2, 608, 612, 788, 807, or 811, and E2F polypeptide comprises about

Art Unit:

amino acid 95 to about amino acid 194 of SEQ ID NO:1, classified in class 514, subclass 2.

- V. Claims 16-31, 34-37, drawn to drawn to a method for treating a hyperproliferative disorder, by administering a nucleic acid encoding a fusion polypeptide, wherein RB domain is wild type RB56, or SEQ ID NO:4, and E2F polypeptide comprises about amino acid 95 to about amino acid 286 of SEQ ID NO:1, classified in class 514, subclass 44.
- VI. Claims 16-31, 34-37, drawn to drawn to a method for treating a hyperproliferative disorder, by administering a nucleic acid encoding a fusion polypeptide, wherein RB domain is wild type RB56, or SEQ ID NO:4, and E2F polypeptide comprises about amino acid 95 to about amino acid 194 of SEQ ID NO:1, classified in class 514, subclass 44.
- VII. Claims 16-31, 34-37, drawn to drawn to a method for treating a hyperproliferative disorder, by administering a nucleic acid encoding a fusion polypeptide, wherein RB has at least one substitution at amino acid 2, 608, 612, 788, 807, or 811, and E2F polypeptide comprises about amino acid 95 to about amino acid 286 of SEQ ID NO:1, classified in class 514, subclass 44.
- VIII. Claims 16-31, 34-37, drawn to drawn to a method for treating a hyperproliferative disorder, by administering a nucleic acid encoding a fusion polypeptide, wherein RB has at least one substitution at amino acid 2, 608, 612, 788, 807, or 811, and

Art Unit:

E2F polypeptide comprises about amino acid 95 to about amino acid 194 of SEQ

ID NO:1, classified in class 514, subclass 44.

In addition, upon the election of any of groups I-VIII, further election of the following patentably distinct species of the claimed invention is required:

Bladder cancer or restenosis.

The inventions are distinct, each from the other because of the following reasons:

The methods of groups I-VIII are distinct because each method uses different means, i.e. different fusion protein constructs, wherein each construct is a distinct invention.

The species diseases are distinct from each other because they are different diseases with different etiology.

Because these inventions are distinct for the reason given above and have acquired a separate status in the art as shown by their different classification, and because the searches for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

Applicants are required under 35 USC 121 to elect a single disclosed group for prosecution on the merits to which the claims shall be restricted.

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

Art Unit:

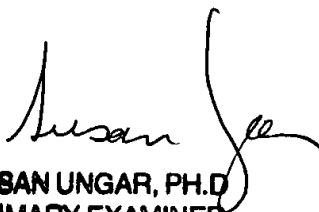
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Tam B. Davis whose telephone number is (703) 305-2008. The examiner can normally be reached on Monday-Friday from 9:30am to 3:30pm, except on Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tony Caputa, can be reached on (703) 308-3995. The fax phone number for this Group is (703) 308-4227.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0916.

Minh-Tam B. Davis

September 23, 2000

  
**SUSAN UNGAR, PH.D**  
**PRIMARY EXAMINER**